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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/054,093	01/22/2002	Linh M. Bui	HO-P02206US0	3598
26271	7590	02/10/2006	EXAMINER	
FULBRIGHT & JAWORSKI, LLP 1301 MCKINNEY SUITE 5100 HOUSTON, TX 77010-3095			VU, JAKE MINH	
			ART UNIT	PAPER NUMBER
			1618	

DATE MAILED: 02/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/054,093	<b>Applicant(s)</b> BUI ET AL.	
	<b>Examiner</b> Jake M. Vu	<b>Art Unit</b> 1618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 January 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-57 is/are pending in the application.
- 4a) Of the above claim(s) 18-57 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

Receipt is acknowledged of Applicant's Response to the Restriction Requirement filed on 01/17/06 and the Information Disclosure Statements filed on 05/17/02, 02/03/03, 04/30/03, 01/07/04, and 06/02/05. Claims 1-57 are pending in the instant application. Claims 18-57 are withdrawn from consideration.

### ***Election/Restrictions***

Claims 18-57 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 01/17/06.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-17 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable copending Application No. 10/264886 and 10/891895. Although the conflicting claims are not identical, they are not patentably distinct from each other because the copending applications recite a diet for promoting comprehensive weight management in companion animals comprising a first stage pet food product for promoting weight loss and a second stage pet food product for maintaining the weight loss, said first stage pet food product comprising, on a dry matter basis, about 35% to about 70% by weight of a protein, about 4% to about 10% by weight of a fat, about 2% to about 25% by weight of a fiber, about 10% to about 35% by weight of a carbohydrate, and about 0.1% to about 2% by weight of a functional ingredient; and said second stage pet food product comprising, on a dry matter basis, about 20% to about 35% by weight of a protein, about 4% to about 10% by weight of a fat, about 2% to about 25% by weight of a fiber, about 25% to about 70% by weight of a carbohydrate, and about 0.1% to about 2% by weight of a functional ingredient (claim 1). The pet food product further comprises Econa oil (claim 8), L-carnitine (claim 4), and linoleic acid (claim 5). The only difference between the instant claims and the copending claims is the addition of two stages of dieting. However, the claims as written could have both stages of dieting with the same percentage of ingredients.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 9-13, and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by HAND et al (US 5,431,927).

Applicant's claims are directed to a process for producing a pet food product comprising: 35-70% of protein; 4-10% of fat; 5-25% of fiber; 10-35% of carbohydrate; and 0.1-1% of a functional ingredient, wherein said functional ingredient modulates metabolism and builds lean muscle mass. Additionally, the product comprises of long-chain fatty acids, linoleic acid, and is a dry pet food.

HAND disclosed a typical pet food product comprised of: 10-35% of protein; 10-20% of fat; 10-25% of fiber; 35-70% of carbohydrate; and 0.01-.40% of vitamins and minerals, which are known to modulates metabolism and builds lean muscle mass (col. 4, line 45-54). Additionally, the food product has soy oil (col. 5, line 21), which contains long-chain fatty acids, such as linoleic acid. The product is a dry pet food (col. 8, line 32).

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***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over HAND et al (cited supra) in view of CUNNINGHAM (*Archer Daniels Midland forms joint venture to produce fat-fighting oil*. Archer Daniel Midland Company: News Release (June 13, 2001).

Applicant's claims are directed to a process for producing a pet food product comprising: 35-70% of protein; 4-10% of fat; 5-25% of fiber; 10-35% of carbohydrate; and 0.1-1% of a functional ingredient, wherein said functional ingredient modulates metabolism and builds lean muscle mass. Additionally, the product comprises of long-chain fatty acids, linoleic acid, and Econa oil and is a dry pet food.

As discussed above, HAND disclosed a typical pet food product comprised of: 10-35% of protein; 10-20% of fat; 10-25% of fiber; 35-70% of carbohydrate; and 0.01-.40% of vitamins and minerals, which are known to modulates metabolism and builds lean muscle mass (col. 4, line 45-54). Additionally, the food product has soy oil (col. 5, line 21), which contains long-chain fatty acids, such as linoleic acid. The product is a dry pet food (col. 8, line 32).

HAND does not teach adding Econa oil into the food product.

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CUNNINGHAM teaches that diacylglycerol from Econa oil lowers body fat.

It would have been obvious to the person of ordinary skill in the art at the time the invention was made to incorporate Econa oil into HAND's pet food product. The person of ordinary skill in the art would have been motivated to make that modification, because obesity poses a life-threatening problem to domesticated animals. The person of ordinary skill in the art would reasonably have expected success, because the fat lowering affects of Econa oil shows promising results in human studies.

#### ***Telephonic Inquiries***


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jake M. Vu whose telephone number is (571) 272-8148. The examiner can normally be reached on Mon-Fri 8:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Hartley can be reached on (571) 272-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jake M. Vu, PharmD, JD  
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MICHAEL HARTLEY  
PRIMARY EXAMINER